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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/534,286

05/22/2006

Jurgen Theuerkauf

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02/19/2009

ROTHWELL, FIGG, ERNST & MANBECK, P.C.

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SUITE 800

WASHINGTON, DC 20005

EXAMINER

GUTMAN, HILARY L

ART UNIT

PAPER NUMBER

3612

NOTIFICATION DATE

DELIVERY MODE

02/19/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-PAT-Email@rfem.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/534,286	<b>Applicant(s)</b> THEUERKAUF, JURGEN	
	<b>Examiner</b> Hilary Gutman	<b>Art Unit</b> 3612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 8-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 17-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 May 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/22/06</u>   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Species A in the reply filed on 1/12/09 is acknowledged.
2. Claims 8-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 1/12/09.

### ***Information Disclosure Statement***

3. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Drawings***

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the curvature of the roof segments in the same direction when in a folded position of claim 1; the curvature of the roof segments face away from a vehicle bottom of claim 2; the curvature of the roof segments face toward a vehicle bottom of claim 3 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant’s use.

#### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase “Not Applicable” should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A

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COMPACT DISC.

(f) BACKGROUND OF THE INVENTION.

(1) Field of the Invention.

(2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.

(g) BRIEF SUMMARY OF THE INVENTION.

(h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).

(i) DETAILED DESCRIPTION OF THE INVENTION.

(j) CLAIM OR CLAIMS (commencing on a separate sheet).

(k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

(l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

5. The disclosure is objected to because of the following informalities: on page 1, line 4, and page 3, lines 4-5, reference to "Patent Claim 1" is inappropriate as the numbering and language of the claims may change throughout prosecution. Referring to specific claims should be avoided. Also on page 1, line 13, "DE 100 436 A1" should perhaps be "DE 100 51 436 A1" to refer to the correct document described. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-7 and 17-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, line 12, recites the curvature of the roof segments are in the same direction when the top is in a folded position. This is unclear since it is apparent that the center roof segment 7 is

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in a position opposite to the front and rear end roof segments when the top is in the folded position.

Claim 2 recites the curvature of the roof segments face away from a vehicle bottom which is unclear in that the curvature of the front and rear roof segments appear to face towards the vehicle bottom while that of the central roof segment does indeed appear to face away.

Claim 3 recites the curvature of the roof segments face a vehicle bottom which is unclear in that the curvature of the front and rear roof segments appear to face towards the vehicle bottom while that of the central roof segment does indeed appear to face away.

Claim 5 recites the limitations "the outer roof frame profile" in line 7 and "it" in line 8". There is insufficient antecedent basis for these limitations in the claim. With regard to the outer roof frame profile perhaps applicant should further state "of the at least one central roof segment" so that it is clear which profile is being specified.

Claim 6 recites the limitation "the outer roof frame profile" in line 3. There is insufficient antecedent basis for this limitation in the claim. Perhaps applicant should further state "of the at least one central roof segment" so that it is clear which profile is being specified.

Claim 17 recites the limitations "the control rod" in line 4 and "the articulated chain" in lines 6-7. There is insufficient antecedent basis for these limitations in the claim.

Claim 21 recites the limitations "an outer roof frame profile" in line 4 and "the body" in lines 7-8. There is insufficient antecedent basis for these limitations in the claim.

Claim 22 recites the limitations "the body" in line 6 and "the outer roof frame profile" in line 6. There is insufficient antecedent basis for these limitations in the claim.

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Claim 23 recites the limitations "the body" in line 4, "it" in line 4, "the body" in line 7.

There is insufficient antecedent basis for these limitations in the claim.

Claim 24 recites the limitations "the outer roof frame profile" in line 5, "the up position" in line 6, "the outer roof frame profile" in lines 8 and 8-9, and "the up position" in lines 9-10.

There is insufficient antecedent basis for these limitations in the claim.

Claim 25 recites the limitations "the outer roof frame profile" in lines 6-7, "the body" in line 8, and "the lever" in line 9. There is insufficient antecedent basis for these limitations in the claim.

Claim 27 recites the limitations "the rear window" in line 4, "the outer roof frame profile" in line 6, and "the flexible roof membrane" in lines 6-7. There is insufficient antecedent basis for these limitations in the claim.

Claim 29 recites the following limitations: "the articulated chain" in line 4, "the first lever" in line 11, and "the 4-bar linkage mechanism" in line 12. There is insufficient antecedent basis for these limitations in the claim. In addition, in claim 29, line 7, the term "and/or" is indefinite as to what the applicant intends to claim, "and" or "or". Modification and clarification should be made.

Claim 30 recites the limitation "the connection" in line 6. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-4, 18-20, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over DE '436 in view of the well known prior art.

DE '436 disclose the claimed invention including a multipart convertible top for a vehicle having a gasket which is pivotably mounted with respect to a movable roof part and which is pivotable inward with respect to the rear-end roof part when the top is stored. DE '436 disclose the roof parts being stored in opposite directions stacked one above the other. The curvature of one segment faces towards a vehicle bottom while the curvature of the other segment faces away. Additionally, the reference does not include three roof segments: a front-end segment, a rear-end segment, and a central roof segment.

However, the examiner takes official notice that convertible tops are well known in the prior art having three segments. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided three segments, as taught by the well known prior art, for the top of DE '436 as an obvious expedient and in order to allow the top to be adapted for various vehicle styles.

***Allowable Subject Matter***

10. Claims 5-7, 17, 21-30 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.



***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hilary Gutman whose telephone number is 571-272-6662.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Dayoan can be reached on 571-272-6659. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hilary Gutman/  
Primary Examiner, Art Unit 3612